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December 10, 2009

VIA EMAIL

Aleksander J. Goranin, Esq.
Woodcock Washburn
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

Re: *Centocor Ortho Biotech, Inc. v. Genentech, Inc., et al.*, Case No. 08-cv-03573, C.D. Cal.

Dear Alex:

I write in response to your letter of December 1, 2009. As you should be aware, on December 4, 2009, Genentech produced a DVD and CD of production documents.

1. Cabilly family prosecution file histories

You request the prosecution file histories of Ser. Nos. 08/909,611; 08/422,187; and 08/931,121. We have already produced those prosecution file histories. *See generally* GNE-MED033199 - GNE-MED040097; GNE-MED092857 - GNE-MED93111; GNE-MED105716 - GNE-MED106974; GNE-MED112194 - GNE-MED114524; GNE-MED116267 - GNE-MED116505; GNE-MED118216 - GNE-MED118249; GENE-CEN008904-8950.

2. All transcripts and exhibits from the *MedImmune v. Genentech* litigation, Civ. A. No. 2:03-cv-02567

We will produce these transcripts and exhibits that are located in a reasonable and diligent search and to the extent that those transcripts and exhibits do not reflect MedImmune confidential information.

3. All pleadings and exhibits from *Cabilly v. Glaxo Wellcome*, Interference No. 104,532

We had already produced a large number of documents from the Glaxo interference, and on December 4 produced over 1,000 additional documents from the Glaxo interference. After reviewing these documents, please advise if you still believe certain exhibits are missing and, if so, which exhibits.

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4. All pleadings, transcripts, and exhibits from the Chiron v. Genentech litigation, Civ. A. No. 2:00-cv-1252

As we explained in our responses to Centocor's requests for Chiron documents, the Chiron litigation was a multi-year litigation that generated voluminous materials much of which was confidential to Chiron or other parties. Further, those materials are irrelevant to this case. Nonetheless, we agreed to produce, and did produce, certain materials from that litigation. *See generally* GNE-MED083625 - GNE-MED087750; GNE-MED123937 - GNE-MED130179.

Although you suggest we have not produced expert materials relevant to invalidity, within the materials already produced are Dr. French's expert reports and deposition and Genentech's brief on appeal. Genentech produced almost 175 documents, including numerous expert reports, depositions, pleadings, and trial transcripts. Despite the fact that we have produced what we agreed to in our responses, we will nonetheless produce the briefing and joint appendix from the appeal docketed in the Federal Circuit as 03-1158, and 03-1159, except that materials from the joint appendix filed under seal and that reflect Chiron confidential information will not be produced.

5. Drafts of written submissions, expert reports, declarations, and other written statements provided to US and European patent authorities

You suggest that our production is deficient because we have not produced "any drafts of the written submissions, expert reports, declarations, and other written statements" provided to US and European patent authorities. We did not, however, agree to produce such drafts. *See, for example*, Genentech's Responses to Centocor's Requests for Production Nos. 3, 23, 30, 56, and 66. Furthermore, pursuant to the Protective Order entered on October 20, 2009, "Drafts of expert reports and notes or outlines for draft reports shall not be discoverable by any party and do not need to be identified on a privilege log."

6. Design, structure, function, and operation of alleged embodiments of Cabilly II

These documents have been or will be produced. *See generally* GNE-MED169536 - GNE-MED186517, GNE-MED347329 - GNE-MED349427.

7. First public use, first public disclosure, first manufacture, first offer of sale, and first sale of alleged embodiments of Cabilly II

The first public use, first public disclosure, first manufacture, first offer for sale, and first sale of the embodiments of Cabilly II occurred long after the filing date of the Cabilly II patent. Please explain the relevance of these documents to this litigation.

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8. All Cabilly license agreements and expert reports relating to same

Numerous Cabilly license agreements have already been produced. *See generally* GNE-MED 45565 - GNE-MED 46443. Certain license agreements require notice and permission of third parties prior to production and we are in the process of securing that permission. We will continue to produce those agreements as we receive permission, as well as any other Cabilly license agreements not yet produced.

A copy of the E. Fintan Walton report, including Appendix 3, will also be produced.

9. Technical documents relating to the development of the invention of the Basey '335 Patent.

These documents were produced on December 4, 2009.

10. Design, structure, function, and operation of alleged embodiments of the Basey '335 Patent

These documents were produced on December 4, 2009.

11. All Basey '335 Patent license agreements

We do not believe there are any licenses identifying or mentioning the '335 patent.

Sincerely,



Marcus E. Sernel

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